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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/654,091

09/04/2003

James J. LeKachman

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EXAMINER

TRAN, HAI

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/654,091	Applicant(s) LEKACHMAN, JAMES J.	
	Examiner HAI TRAN	Art Unit 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/08/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 8, 2009 has been entered.

2. This communication is in response to the Amendments/Remarks filed on June 8, 2009, for application, titled: "System and Method for Financial Instrument Pre-Qualification and Offering".

3. Claims 1, 8, 14 and 31 have been amended. Accordingly, claims 1-31 remain pending and have been examined.

Priority

4. This application claims the benefit of U.S. Provisional Patent Application No. 60/407,696, filed on 09/04/2002.

Claim Rejections - 35 USC § 112

5. Applicant has amended claims 1, 14 and 31 to overcome the rejection. Hence, the rejection is withdrawn.

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6. In addition, Applicant has explained claims 14 and 31. Hence, the rejection is withdrawn.

Claim Rejections - 35 USC § 112

7. Applicant has clarified claims 14 and 31 for the 112, first paragraph rejection. Hence, the rejection is withdrawn.

Response to Arguments

8. Applicant's arguments filed June 8, 2009 have been fully considered but they are not persuasive. The Examiner has carefully reviewed Applicant's arguments and the amended claims and determined that Cunningham reference alone discloses all the limitation in claims 1-31.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Cunningham (U.S. Patent No. 7,310,617) (Cunningham”).

11. **Regarding to Claim 14**, Cunningham teaches a method for offering financial instruments to pre-qualified consumers, comprising:

receiving information related to personal identification information associated with a consumer who is a customer of at least one of a financial institution and an entity associated with the financial institution (see Cunningham, col. 4, lines 7-20; Figure 2/elements 40-50), the consumer personal identification information being transmitted prior to a consumer contact (see Cunningham, col. 5, lines 12-38; Figure 3/elements 60-66);

inquiring a third party based on the received information related to the consumer personal identification information whether the consumer has been pre-qualified for a financial instrument, the financial instrument associated with the financial institution (see Cunningham, col. 4, lines 22-34; Figure 2);

receiving pre-qualification data from the third party wherein the pre-qualification data relates to a determination of whether a consumer identifier associated with the consumer is contained in a suppression database (see Cunningham, col. 3, lines 32-49 “data stored on the database servers 36 and credit bureau information stored remotely (e.g., at the credit bureau) to determine which card offers are appropriate for the user”; Figure 1/elements 24-36), wherein the suppression database comprises a plurality of second consumer files (see Cunningham, col. 6, lines 11-15 “grade/score is calculated”; Figure 4/element 74), each of the second consumer files linked to a unique consumer identifier (see Cunningham, col. col. 3, lines 7-12 “unique identifier”; Figure 1), wherein the second consumer files comprise suppression information relating to a determination

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that the consumer associated with the second consumer file is no longer qualified to be offered one or more of the pre-qualified financial instruments stored in the first consumer file (see Cunningham, col. 6, lines 15-17 “selection criteria”; Figure 4/element 76); and

offering the consumer the financial instrument for which he or she is pre-qualified, if the received pre-qualification data from the third party indicates that the consumer is pre-qualified for a financial instrument (see Cunningham, col. 4, lines 22-58 “Grade A, 770 and above, Offer”, “Grade B, 780 and above, Offer”, “all others, no offer”),

wherein the standards for the consumer pre-qualification are set by the financial institution (see Cunningham, col. 4, lines 23-67; Figure 2/element 50).

12. **Regarding to Claim 15**, Cunningham teaches the method of claim 14, wherein pre-qualification of the consumer comprises checking at least one of the credit rating of the consumer, the income level of the consumer, the debt level of the consumer and the payment history of the consumer with the financial institution (see Cunningham, col. 4, lines 59-3 of col. 5, “financial risk rating”, col. 5, lines 12-6 of col. 6 “determining a rating for an applicant”).

13. **Regarding to Claim 16**, Cunningham teaches the method of claim 15, wherein pre-qualification of the consumer occurs prior to receipt of the consumer personal

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identification information (see Cunningham, between Figure 3/element 66 and Figure 4/element 70).

14. **Regarding to Claims 17-18**, Cunningham teaches wherein the third party maintains consumer information in files indexed by a unique identifier, and wherein the unique identifier relates to the personal identification information of the consumer (see Cunningham, col. 3, lines 10-11 “unique identifier”, col. 5, lines 12-38 “term data are organized in a matrix”).

15. **Regarding to Claim 19**, Cunningham teaches the method of claim 18, further comprising offering the financial instrument to the consumer only if the consumer credit rating meets or exceeds a pre-determined condition (see Cunningham, col. 4, lines 35-58).

16. **Regarding to Claims 20-21**, Cunningham teaches wherein the financial instrument comprises any financial instrument for which credit information relating to the consumer is predictive, and wherein the financial instrument comprises at least one of a car loan, boat loan, loan on investment property, margin account, business loan, second mortgage, home equity line of credit, consumer loan, transaction card, credit card, loyalty card, co-branded credit card, debit card, rewards card, smart card, mutual fund or insurance (see Cunningham, Abstract “credit card, debit card”. The Examiner notes that the “credit” in Cunningham is the same as the “loan” in Applicant’s invention).

17. **Regarding to Claim 22**, Cunningham teaches the method of claim 21, wherein the consumer is offered the financial instrument only if one or more pre-determined conditions are met (see Cunningham, col. 4, lines 35-58).

18. **Regarding to Claim 23**, Cunningham teaches the method of claim 22, wherein the consumer personal identification information is obtained when the consumer makes contact comprises a purchase from a merchant (see Cunningham, col. 4, lines 13-15 “the process begins when a user completes an application by providing personal and financial information”).

19. The Examiner notes that Cunningham does not expressly disclose “a purchase from a merchant”. However, it would not have made any difference since the purpose of this claim is to obtain the consumer personal identification information, Cunningham’s teachings includes obtaining personal and financial information (see col. 4, lines 7-21).

20. **Regarding to Claim 24**, Cunningham teaches the method of claim 22, wherein the consumer personal identification information is obtained through contact comprises one of a communication from a business partner of the financial institution or a communication directly to the financial institution (see Cunningham, col. 4, lines 7-20 “the process begins when an applicant completes an application”; Figure 2/elements 40-50).

21. **Regarding to Claim 25**, Cunningham teaches the method of claim 24, wherein consumer personal identification information is obtained through a telephone call or contact over a computer network (see Cunningham, col. 4, lines 7-20 “the servers at the web/online site 44”; Figure 2/element 44).

22. **Regarding to Claim 26**, Cunningham teaches the method of claim 25, further comprising offering the financial instrument only upon the acceptance of any terms and conditions related to the financial instrument by the consumer (see Cunningham, col. 6, lines 7-28 “a summary of each offer mat be presented in the form of a menu from which the applicant may make a selection to review details of the offer”, “If the applicant accepts an offer”).

23. **Regarding to Claim 27**, Cunningham teaches the method of claim 25, further comprising offering the financial instrument to the consumer only if the identity of the consumer is authenticated (see Cunningham, col. 4, lines 19-21 “The servers at the web/online site prompt the applicant for the required information”).

24. **Regarding to Claim 28**, Cunningham teaches the method of claim 27, wherein authenticating the consumer comprises favorable comparison of stored consumer information to consumer personal identification information (see Cunningham, col. 4, lines 7-21 “facilitate communication between potential financial card customers and participating financial institutions”, “The servers at the web/online site prompt the

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applicant for the required information and then process it". The Examiner notes processing applicant information is the same as comparing stored consumer information to consumer personal identification information).

25. **Regarding to Claim 29**, Cunningham teaches the method of claim 28, wherein the consumer personal identification information comprises at least one of a calling telephone number, a PIN, a password, a biometric or any other information known or held by the consumer and generally not known to the public that can be used to authenticate the consumer (see Cunningham, col. 4, lines 7-21 "telephone number").

26. **Regarding to Claim 30**, Cunningham teaches the method of claim 28, wherein authentication is performed by the third party (see Cunningham, col. 4, lines 22-34 "grading system"; Figure 2/element 48).

27. **Regarding to Claim 31**, this claim corresponds to claim 14 except that includes the limitation of "wherein further the financial instrument comprises any financial instrument for which credit information relating to the consumer is predictive" (see discussion in claims 20-21 above).

28. **Regarding to Claims 1-13**, these claims include the necessary processors and components for implementing the method claims 14-31 and have the same elements

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and limitations. Hence, they are rejected under the same rationale provided in claims 14-31.

Conclusion

29. Claims 1-31 are rejected.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAI TRAN whose telephone number is (571)272-7364.

The examiner can normally be reached on M-F, 9-4 PM.

31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

32. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/H. T./
Examiner, Art Unit 3694

/Mary Cheung/
Primary Examiner, Art Unit 3694